

## REMARKS/ARGUMENTS

Claims 1-11, 13-19 and 21-33 are pending. In this response, claims 1, 13, 15, 18, 27, 29, and 33 are amended. Support for these amendments may be found throughout the Specification.<sup>1</sup> Applicants respectfully submit that no new matter is added. Applicants respectfully request reconsideration of this application based on the following remarks.

### *Interview Summary*

The Applicants thank the Examiner for the courtesies extended to Applicants' representative Tiffany Brooks during the telephone interview conducted on August 17, 2010. The substance of the interview is incorporated into the remarks below.

### *Claim Rejections – 35 USC § 103*

In the Final Office Action, dated March 31, 2010 (hereinafter "Office Action"), Claims 1-3, 7-11, 13, 15, 18, 21-27 and 29-33 are rejected under 35 USC § 103(a) as being unpatentable over US Patent No. 7,130,284 to Lee et al. (hereinafter "Lee"), in view of US Patent Application Publication No. 2001/0016493 to Kim et al. (hereinafter "Kim"), in further view of U.S. Patent No. 6,493,554 to Kanerva et al. (hereinafter "Kanerva"). The Advisory Action, dated June 23, 2010, maintains the rejections from the Office Action. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, all of the claimed features must be taught or suggested by the references and there must be some suggestion or motivation, in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.<sup>2</sup>

Lee, Kim and Kanerva, alone or in combination, fail to disclose or suggest the features recited by the claims. For example, claim 1 recites, among other subject matter, "a first modem processor operative to . . . receive a first message from the first wireless network to perform [a] handoff to the second wireless network, wherein the first message comprises a list of target cells in the second wireless network determined by the first wireless network to have a target cell location corresponding to a location of the wireless device, transmit a search message comprising

<sup>1</sup> See, e.g., Specification, paragraph [0053].

<sup>2</sup> MPEP, section 2142, and *KSR International Co., v. Teleflex Inc.*, No. 04-1350, (US, April 30, 2007).

a list of frequencies corresponding to the target cells to search for in the second wireless network, and provide notification of the handoff” and “a second modem processor operative to receive the search message and determine pilot acquisition for the list of frequencies and additional frequencies not included in the list of frequencies to produce a search result comprising the list of frequencies and the additional frequencies, acquire synchronization and timing for each cell for which pilot acquisition is determined, exchange a second message with the second wireless network implementing a second radio access technology from 3rd Generation Partnership Project 2 (3GPP2) to establish a new call with the second wireless network via one of the cells in the search result, perform a call setup procedure with the second wireless network to establish the new call, and perform processing for the new call with the second wireless network.” Independent claims 13, 15, 18, 27, 29 and 33 each include similar subject matter.

The Office Action, on page 9, admits that Lee and Kanerva fail to disclose determining “pilot acquisition for additional frequencies not included in the list of frequencies” and relies on Kim to cure this deficiency.

Kim, in the Abstract and paragraphs [0059]-[0062], discloses a method “for an idle state handoff in a cellular system” where “a pilot signal is detected from the neighboring base stations by the mobile telephone, and it is then determined whether the detected neighboring base station is included in the list of the neighboring base stations. If the detected neighboring base station is not included in the list, it [is] recognized as a handoff failure.”

Since Kim teaches that the handoff is recognized as a failure if the detected pilot signal is not included in the list of the neighboring base stations, Kim does not disclose or suggest adding the detected pilot signal to the list of neighboring base stations or using the detected pilot signal in establishing the new call.

Thus, in combining Kim with Lee, upon detecting that the pilot signal is not included in the list of the neighboring base stations, the handoff would fail, and would not result in producing a search result with “the list of frequencies and the additional frequencies” and establishing “a new call with the second wireless network via one of the cells in the search result,” as recited in claim 1.

Further, the Office Action, on page 5, asserts that the feature “the new call may be established with a cell on one of the additional frequencies not included in the list” is not recited

in the claims. However, the Applicants respectfully submit that amended claim 1 recites establishing “a new call with the second wireless network via one of the cells in the search result” and that the search result comprises “the list of frequencies and the additional frequencies.” (Emphasis added). Accordingly, this feature is clearly recited by the claims.

In addition, the Advisory Action, on page 4, asserts that Kim discloses “producing a search result based on the determined pilot acquisitions for the list of frequencies and additional frequencies not included in the list of frequencies. A search result is determined such that the mobile telephone is aware of those base stations to which a successful handoff can occur.” Even if Kim did disclose a search result, as suggested by the Office Action, which the Applicants are not admitting to, the Applicants submit that the mobile telephone being aware of those base stations to which a successful handoff can occur does not disclose or suggest adding the detected pilot signal to the list of neighboring base stations or using the detected pilot signal in establishing the new call, as recited in amended claim 1. (Emphasis added). In fact, however, Kim teaches away from the contention in the Advisory Action, and thus teaches away from the recited subject matter, since Kim teaches that the handoff is recognized as a failure if the detected pilot signal is not included in the list of the neighboring base stations.

Moreover, the addition of Kanerva fails to address the above-noted deficiencies of Kim and Lee.

In light of the foregoing, Applicant respectfully requests withdrawal of the rejection of independent claims 1, 13, 15, 18, 27 and 29. Claims 2-3, 7-11, 21-26 and 30-32 depend either directly or indirectly from claims 1 and 18, respectively. Thus, Applicant submits that claims 2-3, 7-11, 21-26, and 30-32 are allowable at least for the reason that they depend from an allowable base claim, as well as the additional features recited therein.

Therefore, based on the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-3, 7-11, 13, 15, 18, 21-27 and 29-33 under 35 USC § 103(a) as being unpatentable over Lee in view of Kim and in further view of Kanerva.

#### ***Claim Rejections – 35 USC § 103***

Claims 4, 14, 16, 19 and 28 are rejected under 35 USC § 103(a) as being unpatentable over Lee, Kanerva and Kim in view of U.S. Patent Application Publication No. 2003/0139184 to Singh et al. (hereinafter “Singh”). Claims 5 and 6 are rejected under 35 USC § 103(a) as being

unpatentable over Lee, Kanerva and Kim in view of U.S. Patent Application Publication No. 2004/0203469 to Patel et al. (hereinafter "Patel"). Applicants respectfully traverse this rejection.

Claims 4-6, 14, 16, 19 and 28 depend either directly or indirectly from claims 1, 13, 15, 18, and 27, respectively, and thus are allowable over Lee, Kanerva and Kim for at least the same reasons as discussed above. Further, Singh and Patel do not cure the deficiencies of Lee, Kanerva and Kim. .

Therefore, based on the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of claims 4-6, 14, 16, 19 and 28 under 35 USC § 103(a) as being unpatentable over Lee, Kanerva, Kim, and Singh or Patel.

***Claim Rejections – 35 USC § 103***

Claim 17 is rejected under 35 USC § 103(a) as being unpatentable over Singh in view of Lee in further view of Kim in further view of Kanerva. Applicants respectfully traverse this rejection.

As previously discussed, Lee, Kim and Kanerva do not disclose or suggest "a search result comprising pilot acquisitions determined for the list of frequencies and additional frequencies not included in the list of frequencies" and establishing "via one of the cells in the search result," as recited in claim 17. Singh does not cure the deficiencies of Lee, Kim and Kanerva.

Therefore, based on the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of claim 17 under 35 USC § 103(a) as being unpatentable over Singh in view of Lee in further view of Kim in further view of Kanerva..

### CONCLUSION

In light of these remarks, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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